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EXAMINER	
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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/940,974  
Filing Date: August 28, 2001  
Appellant(s): Wayne Lewis Dickerson, Jr.

Joseph J. Christian  
For Appellant

**REQUEST FOR RECONSIDERATION AND REHEARING**

It is respectfully requested that the appeal in the above-identified application be reheard and reconsidered by an expanded panel of the Board of Patent Appeals and Interferences on the written record, as supplemented below. It is believed that the original panel erred in determining that the invention, as claimed in claims 23 and 26-30, are directed to statutory subject matter under 35 U.S.C. §101.

**Period for Reply**

The Appellant may file a reply to this request within one (1) month of the mailing date of this request for rehearing. After the expiration of this period, plus appropriate time for mailing, this application and request will be forwarded to the Board of Patent Appeals and Interferences for consideration.

## **Summary of the Invention**

The invention involves a method for identifying a solution to address exposed performance gaps and for generating a value proposition of a company in the grocery store industry.

## **Issues on Appeal**

The issue on appeal is as follows:

1) 35 U.S.C. §101 rejection of method claims 23 and 26-33 as being directed to non-statutory subject matter.

## **Decision by the Board**

The original panel reversed the 35 U.S.C. §101 rejection of claims 23 and 26-33 in a decision dated July 13, 2009. The decision states in the second full paragraph of page 15 that the examiner “applied the useful, concrete, and tangible result inquiry to determine that claims 23 and 26-33 are non-statutory because they lack concreteness. However, the U.S. Court of Appeals for the Federal Circuit (Federal Circuit) has held that ‘the useful, concrete and tangible result inquiry is inadequate [to determine whether a claim is patent-eligible under §101.]’ *In re Bilski*, 545 F.3d 943, 959-60 (Fed. Cir. 2008) (en banc).”

The decision further states at the first full paragraph of page 16 that “Claims 23, 29, 30 are drawn to processes (FF 1-10) which are statutory if they meet the machine-or-transformation test. ‘A claimed process is surely patent-eligible under §101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing.’ *Id.* at 954, citation omitted. We find that claims 23, 29 and 30 recite a computerized method which includes a step of outputting information from a computer (FF 7 and 9-10) and therefore, are tied to a particular machine or apparatus.”

In the second full paragraph of page 16, the decision further stated “we find that the Examiner

erred in rejecting claims 23 and 26-33 under 35 U.S.C. §101 as being directed to non-statutory subject matter”.

### **Issue for Reconsideration**

The issue to be addressed in this reconsideration is whether the original panel erred in its application of *Bilski* in determining that the method claims 23 and 26-30 are tied to a particular machine because they recite a “computerized method which includes a step of outputting information from a computer”.

Note that the reversal of the 35 U.S.C. §101 rejection of claims 31-33 is not part of this reconsideration.

### **Analysis of the Issues**

#### Reversal of the §101 Rejection of Method Claims 23 and 26-30

Although *In re Bilski* certainly requires testing method claims for subject matter eligibility by determining whether the claimed method is (1) tied to a particular machine or apparatus, or (2) transforms a particular article to a different state or thing, this is not the entirety of the tests set forth in *Bilski*. As discussed by the Federal Circuit in *Bilski*”, there are two corollaries to the machine-or-transformation test. First, “As a corollary, the *Diehr* Court also held that mere field-of-use limitations are generally insufficient to render an otherwise ineligible process claim patent-eligible.” *Bilski*, 545 F.3d at 957. Second, “The *Diehr* Court also reaffirmed a second corollary to the machine-or-transformation test by stating that ‘insignificant postsolution activity will not transform an unpatentable principle into a patentable process.’”, which the court later characterized as “insignificant extra-solution activity”. *Id.*.

As noted above, the original panel indicated on page 16 of its decision that the method claims are tied to a particular machine because they recite a “computerized method which includes

a step of outputting information from a computer” and referenced their findings of fact FF 7 and 9-10. FF 7 merely finds that “Claim 23 recites ‘outputting the solution from the computer system.’”. FF 9-10 find the same limitation in claims 29 and 30, respectively.

Even though each of independent method claims 23, 29 and 30 recite outputting the solution from a computer, applying the second corollary clearly results in the conclusion that this outputting is insignificant extra solution activity. Note that the recited outputting step is not central to the purpose of the method invented by applicant. As indicated for example on page 3, lines 12-16 of applicant’s specification, the focus of the disclosed invention lies in overcoming the drawbacks of the prior art by “generating a value proposition” and increasing value of a company in an industry by identifying a solution based on impact and performance gaps, rather than any specific outputting. Note also that the recited outputting does not apply or provide the result of the method in any particular manner. Any and every output would be covered by this limitation. Therefore, reciting a specific machine in an insignificant step, “such as data gathering or *outputting*” (emphasis added), is not sufficient to pass the test. *See Bilski*, 545 F.3d at 957.

As a result, the recited outputting from the computer system in claims 23, 29 and 30 is not a sufficient tie to pass the *Bilski* test. Dependent method claims 26-28 do not provide any additional, positive recitation of a tie to a machine or transformation. With respect to the recitation in the preambles of a “computerized method”, note the Board’s Informative opinion in *Ex parte Langemyer*, available at <http://www.uspto.gov/web/offices/dcom/bpai/its/fd081495.pdf>, where it was stated that a preamble reciting a “method executed in a computer apparatus” was “so generic as to encompass any computing system, such that anyone who performed this method in practice would fall within the scope of these claims...the recitation of a computer apparatus in the preamble is not, in fact, a limitation at all to the scope of the claim, and the claim is directed, in essence, to the method performed by any means”. Therefore, method claims 23 and 26-30 cannot be said to be patent eligible subject matter in light of *Bilski*, contrary to the decision by the original panel.

## Conclusion

For the reasons set forth above, it is respectfully requested that the decision of the Board of Patent Appeals and Interferences dated July 13, 2009, be reconsidered by an expanded panel and that the rejection of claims 23 and 26-30 under 35 U.S.C. §101 be sustained.

Respectfully submitted,

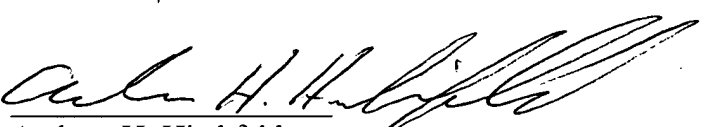
  
/Bradley Bayat/ 07/14/2009

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Approved

  
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